a

ARENSI-MARLEY (M) SDN BHD

v.

MIDDY INDUSTRIES SDN BHD

b

HIGH COURT MALAYA, KUALA LUMPUR
VINCENT NG J
[ORIGINATING MOTION NO: D1-25-10-2002]
25 FEBRUARY 2004

c

PATENTS: *Registered designs - Expungement - Application for - Whether application should be made under ss. 24 or 27 of the Industrial Designs Act 1996*

d

PATENTS: *Registered designs - Differences - Whether differences in designs merely immaterial differences or common variants in the trade - Whether such features attributed originality and newness instead*

The applicant's main product was a rainwater gutter system known as the Rainwater System. The applicant was also the copyright owner in respect of artistic work in the Designs of a rain gutter ('gutter designs'). The applicant claimed that the respondent's design 372 was not only a substantial reproduction e of the applicant's own gutter designs but was also designed to only fit the applicant's Rainwater System. The applicant thus applied for an order that the respondent's Design 372 be expunged and removed from the Register of Industrial Designs, Malaysia ('the Register') under s. 24(1) of the Industrial Designs Act 1996 ('the Act'). The respondent opposed the application on the f grounds that Design 372 was not only registered in Malaysia but also in the United Kingdom, and was significantly different from the applicant's gutter designs. The applicant however argued that the differences were either immaterial differences or common variants in the trade. The High Court had to determine the preliminary issue whether the applicant was correct in seeking g to expunge Design 372 under s. 24(1) of the Act; and deal also with the merits of the application.

Held:

[1] Section 24 of the Act is clearly limited to making, expunging or varying h an 'entry' in the Register as opposed to s. 27 which clearly is concerned with the revocation of the registration of a design as a whole. Thus, the application should have rightly been made under s. 27 of the Act. More

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so considering that the application was founded on the applicant's belief that it's design was prior art which predated the priority date for the respondent's design. (p 23 b-d)

[2] The High Court judge's first visual impression of Design 372 was that it was new. The features that the applicant was seeking to dismiss as immaterial differences or common variants in the trade were the very features that attributed originality and newness to Design 372. (p 25 e)

Case(s) referred to:
Besalon International Ltd & Ors v. South Strong Industries Sdn Bhd [1997] 1 CLJ Supp 335 HC ***(refd)***
British Franco Electric Pty Ltd v. Dowling Plastics Pty Ltd [1981] 1 NSWLR 448 ***(refd)***
Control Pty Ltd v. Meco McCallum Pty Ltd & Anor (Federal Court of Australia) ***(refd)***
Household Articles Ltd's Registered Design [1998] FSR vol 25 676 ***(refd)***
Macrae Knitting Mills Ltd v. Lowes Ltd [1963] 55 CLR 725 ***(refd)***
Philips v. Harbro Rubber Co [1920] 376 RPC 233 ***(refd)***
Re Clarke's Design [1896] 2 Ch 38 ***(refd)***
Vandervell & Co v. Lundberg & Sons [1916] 33 RPC 60 ***(refd)***

Legislation referred to:
Industrial Designs Act 1996, ss. 24(1), 27

Other source(s) referred to:
The Modern Law of Copyright and Design, 1995, Butterworths, 2nd edn, p 1131

For the applicant - Chew Kherk Ying (Elaine Yap); M/s Wong & Partners
For the respondent - SF Wong (Sri Dev Nair & M Raj Kumar); M/s Sri Dev & Naila

Reported by Andrew Christopher Simon

JUDGMENT

Vincent Ng J:

Preamble
Enclosure 1 is the applicant's application for an order that the respondent's Industrial Design Registration No: MY 01-00372 (Design 372) be expunged and removed from the Register of Industrial Designs, Malaysia under s. 24(1) of the Industrial Designs Act 1996 (the Act).

Background
The applicant manufactures and markets uPVC rainwater products in Malaysia. Their main product is a rainwater gutter system known as Rainwater System; which consists of rain gutters and gutter fittings which when fitted together, form a complete gutter system for a house or building.

The applicant is also the copyright owner in the original artistic work comprised in the designs of a rain gutter including 3-dimensional reproduction of the designs being part of a whole gutter system (Gutter Designs).

In early April 2002, the applicant was alerted to Design 372 which they maintain was not only a substantial reproduction of their own Gutter Designs but also designed to only fit the applicant's Rainwater System. The applicant submitted that the respondent's representations in their design registration dated 16 July 2001, were almost identical to their Gutter Designs or different from them only in immaterial details. For this reason, the applicant sought to invalidate the registration of Design 372 and have the same expunged from the Register of Industrial Designs, Malaysia.

The respondent opposed the application on the grounds that Design 372, which is not only registered in Malaysia but also in the United Kingdom, was significantly different from the applicant's Gutter Designs.

Preliminary issues

Before proceeding to consider the merits of this application, let me first address the preliminary issues raised by the respondent.

Firstly, on the question of whether the applicant had complied with the mandatory provisions of s. 24(2) of the Act and reg. 28(2) of the Industrial Designs Regulations 1999, which required service of the application and the supporting affidavit on the Registrar of Industrial Designs; I am satisfied that they had done so on 10 July 2002.

Secondly, on the question of whether the applicant was correct in seeking to expunge of the Design 372 under s. 24(1) of the Act; I considered the provisions of both s. 24 and s. 27 of the Act.

Section 24(1) of the Act reads as follows:

> Subject to the provisions of this Act:
>
> (a) The Court may, on the application in the prescribed manner, of any persons aggrieved by or interested in the non-inclusion in or omission from the Register of any entry, or by or in any entry made in the Register without sufficient cause, or any entry wrongfully remaining in the Register, or any error or defect in any entry in the Register, make **such order for including, making, expunging or varying any such entry** or for correcting of any such error or defect **as it deems fit**; …

whilst s. 27(1) of the Act reads as follows:

> **At any time after the registration of an industrial design,** any person may apply to the Court:
>
> (a) **for the revocation of the registration of the industrial design** on the ground, subject to section 12, that the industrial design has been disclosed to the public prior to the priority date of the application for registration of the industrial design; … (emphasis added).

Giving the words of the provisions its plain and ordinary meanings, it is clear that s. 24 is limited to making, expunging or varying an 'entry' in the register as opposed to s. 27 which clearly is concerned with the revocation of the registration of a design as a whole. It could hardly have been the intention of the legislature to include two statutory provisions in the same Act granting identical reliefs.

I am of the opinion that this application should have rightly been made under the purview of s. 27 of the Act. More so, considering that the application was founded on the applicant's belief that their design was prior art which predated the priority date for the respondent's design.

Merit of the application

Despite this, I went on to consider the merits of the application for I am completely ad idem with the observations of Lindley LJ in *Re Clarke's Design* [1896] 2 Ch 38:

> **The only protection afforded to the public against the abuse of the Act and the acquisition of mischievous monopolies for designs which are neither new nor original,** but which have escaped the vigilance of the comptroller and been improperly registered, i**s the protection of a Court** when its aid is invoked by the registered owner of a design against an alleged infringer, or by a person aggrieved who applies to expunge a registered design from the register. (emphasis added).

The crux of the applicant's contention was that the Design 372 was a wrongfully entry in the Register of Industrial Designs and therefore invalid because the design was not new.

Section 12(2) of the Act provides that:

> An industrial design for which an application for registration is made shall not be considered new if, before the priority date of the application, it or an industrial design differing from it in immaterial details or in features commonly used in the relevant trade:

(i) was disclosed to public anywhere in Malaysia; or

(ii) … (emphasis added).

The burden on the applicant is two-fold; they have to show that:

(i) the Design 372 was not new because it was similar to their own Gutter Design which was prior art and

(ii) any differences in the designs was only in immaterial details and in features commonly used in the trade.

Reference was made to the applicant's sale and promotions including newspaper and trade journal advertisements, brochures and other promotional events since 1994; all predating the respondent's the priority date of 16 July 2001. The applicant sought to rely on Dato' Kamalanathan Ratnam's judgment in *Besalon International Ltd & Ors v. South Strong Industries Sdn Bhd* [1997] 1 CLJ Supp 335 wherein His Lordship held that:

> Any prior use or prior publication in Malaysia will therefore destroy the novelty. It may well be however, that the novelty will still exist in the United Kingdom and the original design registration may remain valid on the United Kingdom register in terms of novelty. **This is simply because the question of novelty is territorial.** (emphasis added).

The applicant submitted that the Design 372 was identical to their Gutter Design; save for the non-closure of the upper ends of the sides of the gutter and the external longitudinal ribs across the sides of the gutter. These differences, the applicant maintained, were common variants in the trade and the respondent should not be entitled to monopolise them by means of design registration. (See *Macrae Knitting Mills Ltd v. Lowes Ltd* [1963] 55 CLR 725, *British Franco Electric Pty Ltd v. Dowling Plastics Pty Ltd* [1981] 1 NSWLR 448 and *Control Pty Ltd v. Meco McCallum Pty Ltd & Anor* (Federal Court of Australia, unreported).)

To assess the extent to which one design differed from the other, I was guided by the principle set out in *The Modern Law of Copyright and Design* (p. 1131, 2nd edn, 1995, Butterworths):

> In reality, of course, the court assesses novelty itself. Except in the most borderline of cases it is unlikely that the judge will defer to the opinion of witnesses where he has already come to view on novelty. Therefore, **it is the court's first visual impression which counts**. (emphasis added)

(*See Philips v. Harbro Rubber Co* [1920] 376 RPC 233 and *Household Articles Ltd's Registered Design* [1998] FSR Vol. 25 676.)

I carefully examined the following:

(i) the applicant' Gutter Design (exh. WKF 18 encl. 7);

(ii) the respondent's registered design (exh. WKF 18 encl. 7);

(iii) other rain gutters available in Malaysia (exh. WKF 19 encl. 7); and

(iv) other rain gutter designs registered in the United Kingdom (exh. CKP 3 encl. 6);

bearing in mind the Laddie J's *dicta* in *Household Articles Ltd's Registered Design (supra)* at 683 that:

> *A design may be valid over prior art even though individual features are very similar. To the eye the impact of small differences may be considerable. Conversely differences may be substantial but the overall visual impact may be very similar.* Language is not well suited to explaining why in each case. (emphasis added).

Looking at all these designs in their entirety, my first visual impression of Design 372, with its non-closed ends and longitudinal ribs, was that it was new. None of the prior publications of rain gutters showed non-closed ends at the terminal edge of the side walls or longitudinal ribs along the three sides. These features, that the applicant was seeking to dismiss as immaterial differences or common variants in the trade, were the very features that attributed originality and newness to Design 372.

Although Younger J opined that "no high standard of inventiveness is required to constitute novelty" in *Vandervell & Co v. Lundberg & Sons* [1916] 33 RPC 60 at 68, I found that the presence of a non-closed end and longitudinal ribs was substantial to give Design 372 the required newness. Aside from its overall aesthetic appeal, the fact that the non-closed ends allowed the rain gutters to be affixed with its brackets concealed, could not be treated as mere workshop alterations.

Conclusion

The applicant has failed to discharge the onus on them. I am satisfied that the Design 372 was validly granted registration in Malaysia and as such should be allowed to remain in the Register of Industrial Designs, Malaysia.

The applicant's application in encl. 1 is hereby dismissed with costs.